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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,634	07/26/2001	Wei Yen	196.1004.01	8462

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EXAMINER

HARRELL, ROBERT B

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/916,634

Applicant(s)

YEN ET AL.

Examiner

Robert B. Harrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2001.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-42 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 26 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20020507.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: see attached Office Action.

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1. Claims 1-42 are presented for examination.
2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
3. Related Applications as mentioned on page 6 must be moved to a new section entitled "Related Applications" prior to "Background Of The Invention" on page 1. Also, the status of the related applications must be updated (i.e., still pending, abandoned, or United States Patent Number, exc...).
4. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks TM, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (no period for claim 36 as just one typographical error example). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

6. Claims 1-42 are rejected under 35 U.S.C. 102 (e) as being anticipated by Hogan et al. (US 6,785,712 B1).
7. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the

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substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions.

8. Per claim 1, Hogan taught a method for sending electronic mail, including separating at least one attachment (e.g., see col. 4 (line 55)) from a text portion in an electronic mail message (e.g., see col. 4 (lines 54-67)) such that a link (e.g., see col. 5 (lines 1-15)) is created between said at least one attachment and said text portion, delivering (e.g., see col. 5 (lines 26-63)) to a recipient said text portion separately from said at least one attachment (e.g., see Abstract)); and making said at least one attachment available from said text portion (e.g., see col. 5 (lines 1-15)).

9. Per claim 1 above, Hogan taught of separating email text from email attachments (which might be big attachments) and inserting a URL into the email text such that the large attachment can be obtained via an out of band link (in that HTML (port 88) is out of band with respect to SMTP (port 25); also port 21 (FTP) could be apart of a URL (i.e., a colored link that is to ftp://someplace_machine.com)).

10. Per claims 2, 3, 4, 5, 6, 7, 8, 9, and 10, Hogan's figure 3 showed that the mail was composed by a first user at a sending device and delivered to a second user at a recipient device and cached at the ground server gateway, running an Application Service Provider software, which was relatively close to the first user sender or could be cached (e.g., see col. 7 (line 7)) at the airborne server gateway relatively local to the recipient. It should be noted that Hogan is directed to general Internet email, thus it was anticipated for two passengers to send mail to each other thus the gateway would be local to both the sender and the receipt.

11. Per claims 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, and 21, the URL mentioned in col. 5 (lines 1-15) was a hypertext link (HTTP means HyperText Transfer Protocol per col. 5 (line 5) and col. 6 (line 65)) based upon a probe for a format (claim 15 contains an "or" condition, thus only one claimed element need be addressed). As indicated above, the text was first sent to the receipt, and within in the text was a non-email transfer protocol (HTTP) URL to the pre-fetched (i.e., downloaded in advance) cached attachment in the gateway(s) location that was received at a later time by the recipient after the recipient clicked on the published URL. Such an invention had a motive that was monetarily driven per col. 1 (line 38 "control cost" and lines 46-et seq.)).

12. Per claims 22-42, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above in that the disclosed corresponding structures within the specification of this application has been either shown to be the same or equivalent to those detailed above and/or in Hogan.


13. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

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14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack B. Harvey, can be reached on (571) 272-3896. The fax phone number for all papers is (703) 872-9306.

16. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL
PRIMARY EXAMINER
GROUP 2142